

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY J. PONTECORVO

Appeal No. 2004-0120
Application No. 09/898,334

ON BRIEF

Before WALTZ, WARREN, and KRATZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 20, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a binder for holding a plurality of sheets, including a front member, a back member, and a spine connecting means, where at least one whiteboard is attached to the outside surface of the front member, the inside surface of the front member, or the

Appeal No. 2004-0120
Application No. 09/898,334

outside surface of the back member and/or spine connecting means
(Brief, page 2).

Appellant states that the claims should be considered in two groups as grouped in the two rejections under appeal (Brief, pages 4-5). We construe this statement as meaning that the claims stand or fall together for each ground of rejection, and thus we select one claim from each ground of rejection and decide the rejection on the basis of this claim alone. See 37 CFR § 1.192(c)(7)(2000); and *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). A copy of illustrative independent claim 1 is attached as an Appendix to this decision.

The examiner relies upon the following references as evidence of obviousness:

Lazar	4,589,685	May 20, 1986
Ong	5,876,143	Mar. 2, 1999
Dottel	5,971,650	Oct. 26, 1999

Claims 1-18 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dottel in view of Lazar (Answer, page 3, referring to the rejection set forth in the final Office action dated Nov. 5, 2002, Paper No. 6). Claim 19 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Dottel in view of Lazar and Ong (Answer, page 4; see Paper No. 6). We *affirm* the examiner's rejections on appeal essentially for the reasons

stated in the Answer, the final Office action (Paper No. 6), and those reasons set forth below.

OPINION

The examiner finds that Dottel discloses a binder comprising a front member and back member with inside and outside surfaces; a fastener and spine connecting means for holding the front and back members together; where the cover is movable by a hinge arrangement; a binding means for binding sheets and a label attached to an outside surface of the spine (Paper No. 6, page 3). The examiner recognizes that Dottel fails to disclose a label being a whiteboard (*id.*).¹ Therefore the examiner applies Lazar for the disclosure of a whiteboard label² which can be attached to an article to provide a readily changeable label (*id.*). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in the art to modify the binder of Dottel to include the whiteboard label taught by

¹As discussed above, we select claim 1 from the grouping of rejected claims and decide this ground of rejection on the basis of this claim alone. See 37 CFR § 1.192(c)(7) (2000).

²According to appellant, "[w]hiteboards' are known and are meant to denote [sic, denote] flat surface components, which receive marker and similar writings and are readily erasable." Specification, page 6, ll. 10-12.

Lazar for the purpose of providing a changeable labeling system (*id.*). We agree.

Appellant argues that Lazar does not teach a binder anywhere in the text or drawings (Brief, page 7). As correctly noted by the examiner (Answer, page 4), Dottel is relied upon to show the basic binder with a label³ while Lazar is relied upon for the teaching of a whiteboard labeling system for articles in general, specifically video or audio cassettes. A reference is available for all that it discloses and suggests to one of ordinary skill in the art, and is not limited to its preferred embodiments. See *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976). Therefore appellant's argument is not persuasive.

Appellant argues that there is no suggestion, teaching or need, expressed or implied, in either Dottel or Lazar to utilize the teachings of the other (Brief, page 8). Appellant submits that one making filing devices as taught by Dottel would not turn

³We note that Dottel does not specifically describe or number what appears to be a label on the spine 2 (see Figure 5). However, since appellant agrees with the examiner that the structure on the spine 2 of Dottel is a label (Brief, page 8, second full paragraph), we accept the examiner's finding regarding the label of Dottel.

to the art of toys and novelties, as taught by Lazar, for information on how to make labels (*id.*).

Appellant's arguments are not persuasive. Appellant does not contest that Dottel discloses a binder with a label on its spine (Brief, page 8, second full paragraph). It was well known in the binder art that a changeable labeling system was desired.⁴ Lazar teaches that "[i]n some applications however a changeable label is desirable, in that the contents of the article or the status of the article has changed." Col. 1, ll. 15-18. Thus Lazar teaches use of a "magic slate" label, i.e., a whiteboard, to provide a changeable labeling system (col. 2, ll. 15-20). As taught by Lazar, the changeable labeling system "can be used on a multitude of articles" and, although exemplified by use on video cassettes or holders, "this invention is by no means limited in its application." Col. 2, ll. 55-59. Accordingly, we determine

⁴See U.S. Patent No. 6,109,812, as discussed on pages 4-5 of the specification. It is axiomatic that admitted prior art in an applicant's specification may be used in determining the patentability of a claimed invention (*In re Nomiya*, 509 F.2d 566, 570-71, 184 USPQ 607, 611-12 (CCPA 1975)); and that consideration of the prior art cited by the examiner may include consideration of the admitted prior art found in an applicant's specification (*In re Davis*, 305 F.2d 501, 503, 134 USPQ 256, 258 (CCPA 1962); *cf.*, *In re Hedges*, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986)). We also note that Ong, cited by the examiner against claim 19 on appeal, is directed to binders with removable inserts to achieve a changeable labeling system (see Fig. 5B).

that the admitted prior art expresses the need for a changeable labeling system, as taught by Lazar, in the binder of Dottel. We disagree with appellant's assessment of Lazar as directed to "toys and novelties" (Brief, page 8) since it is clear that Lazar is directed to changeable labeling systems (e.g., see the title and abstract, as well as the specific uses on video and audio cassettes and holders).

Appellant argues that, even if the combination of references is "valid," the references fail to show front side or back side labels, much less whiteboard labels with transparent covers on front or back sides (Brief, page 8). This argument is not well taken since it is based on features not recited nor required in the claim under consideration (claim 1 on appeal).

With regard to the rejection of claim 19, appellant reasserts all of the previous arguments (Brief, page 9). Accordingly, we adopt our remarks and discussion from above, as well as the examiner's findings and conclusions of law from the final Office action and the Answer. Appellant further argues that the combination of Lazar and Ong is inappropriate because they "teach away" from each other, Lazar directed to a labeling

Appeal No. 2004-0120
Application No. 09/898,334

system where the label remains attached while Ong teaches that a label is replaced every time the title is modified (Brief, page 10).

Appellant's argument is not persuasive. Lazar teaches that the writing surface of the label may be protected by a transparent sheet (col. 2, ll. 30-34; Paper No. 6, page 3). Furthermore, Lazar teaches that the whiteboard label may be secured to a holder (i.e., a binder) in any desirable manner (see col. 4, ll. 59-65). Ong has been applied by the examiner to show a method of attaching a label to a binder by inserting the label (42) in a pocket (30') located on any member surface (Paper No. 6, page 4; Answer, page 5). Accordingly, we determine that Lazar and Ong do not teach away from each other but merely teach different methods of attaching a label to an article.

For the foregoing reasons, as well as those stated in the Answer and in the final Office action (Paper No. 6), we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, we affirm the rejection

Appeal No. 2004-0120
Application No. 09/898,334

of claims 1-18 and 20 under 35 U.S.C. § 103(a) over Dottel in
view of Lazar and the rejection of claim 19 under 35 U.S.C.
§ 103(a) over Dottel in view of Lazar and Ong.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

Charles F. Warren)	
Administrative Patent Judge)	
)	
)	
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)	BOARD OF PATENT
Thomas A. Waltz)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
Peter F. Kratz)	
Administrative Patent Judge)	

TAW/tdl

Appeal No. 2004-0120
Application No. 09/898,334

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APPENDIX

1. A binder for holding a plurality of sheets, which comprises:

- (a.) a front member, having an outside surface and an inside surface;
- (b.) a back member, having an outside surface and an inside surface;
- (c.) connecting means for holding said front member and said back member together;
- (d.) binding means for temporarily binding a plurality of sheets between said front member and said back member; and,
- (e.) at least one whiteboard attached to at least one of said outside surface of said front member, said inside surface of said front member, said outside surface of said back member and said connecting means.